

REMARKS

I. Status of the Claims

Claims 1-2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66, 73, and 80-84 are currently pending, with claims 80-84 being withdrawn as directed to non-elected subject matter. No amendments are provided herein.

Applicants thank the Examiner for acknowledging the receipt of the certified English translation of U.S. Provisional Application No. 60/454,620, filed March 17, 2003. Office Action at page 2.

Applicants further thank the Examiner for acknowledging that claims 32 and 37 are pending because the elected species is present in these claims. *Id.* Applicants respectfully note that the Examiner does not explicitly list claims 32 and 37 in the claim rejections of the present Office Action. See *id.* at pages 2 and 7. However, Applicants note that claims 32 and 37 are marked as rejected on the Office Action Summary. As such, Applicants respectfully request clarification as to the status of these claims.

Finally, the Examiner states that “[t]his application contains claims 80-84 drawn to an invention nonelected with traverse in the reply filed on 10/29/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144).” *Id.* at page 12. However, Applicants note that the Amendment and Response to Restriction and Election of Species Requirement, filed October 29, 2007, was made without traverse, as the Examiner expressly noted in her December 31, 2007, Office Action at page 2. As such, cancellation of nonelected claims is not required. See M.P.E.P. § 821.02.

II. Rejections under 35 U.S.C. § 103

(a) Rejection based on Commonly Owned Patents and/or Applications

The Examiner maintains the rejection of claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,258,852 (the '852 patent) or U.S. Patent Application Publication Nos. 2003/0108503 (the '503 publication) or 2003/0103927 (the '927 publication) or 2004/0001796 (the '796 publication) or 2003/0103929 (the '929 publication) taken individually or in combination with U.S. Patent Application Publication Nos. 2004/0197356 (the '356 publication) or 2004/0197355 (the '355 publication) for the reasons set forth in the Office Action at pages 2-7. In particular, the Examiner alleges that the statement of common ownership, made in the Response under 37 C.F.R. § 1.111, filed March 31, 2008, is "unpersuasive" because it does not use the language "at the time the invention was made," which is the language found in M.P.E.P. § 706.02(l)(2). Office Action at pages 6-7. Applicants respectfully disagree.

The statement of common ownership made in the Response under 37 C.F.R. § 1.111, filed March 31, 2008, says that the patents and publications "were commonly assigned to L'Oréal S.A. at the time of invention." See Response under 37 C.F.R. § 1.111 filed March 31, 2008, page 4 (emphasis added). Since "time of invention" is synonymous with "time the invention was made," Applicants respectfully believe that the March 31, 2008, statement of common ownership is sufficient. Nonetheless, solely to expedite prosecution, Applicants provide another statement of common ownership below using the language that the Examiner requires.

In accordance with 35 U.S.C. § 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Applicants herein certify that the '852 patent, the '503 publication, the '927 publication, the '796 publication, and the '929 publication were commonly assigned to L'Oréal S.A. at the time the invention of the present application was made. The present application is assigned to L'Oréal S.A., as recorded on July 28, 2004 at Reel 015625, Frame 0721. The '852 patent is assigned to L'Oréal S.A., as record on December 10, 2002, at Reel 013567, Frame 0428. The '503 publication is assigned to L'Oréal S.A., as recorded on December 9, 2002, at Reel 013556, Frame 0790. The '927 publication is assigned to L'Oréal S.A., as recorded on December 10, 2002, at Reel 013567, Frame 0430. The '796 publication is assigned to L'Oréal S.A., as recorded on December 10, 2002, at Reel 013568, Frame 0452. Finally, the '929 publication is assigned to L'Oréal S.A., as recorded on December 9, 2002, at Reel 013620, Frame 0096.

Accordingly, Applicants respectfully submit that the rejections based on the '852 patent, the '503 publication, the '927 publication, the '796 publication, and the '929 publication are improper, and should be withdrawn.

(b) Rejection based on Non-L'Oréal Patents and/or Publications

The Examiner maintains the rejection of claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent

Nos. 6,635,702 (the '702 patent) and 5,580,494 (the '494 patent), as well as WO 2002/096385 (WO '385) and WO 2002/096377 (WO '377) for the reasons set forth in the Office Action at pages 7-12. Specifically, the Examiner alleges, *inter alia*, that the '702 patent suggests adding calcium carbonate, the purpose of which would be to "provide stability." See *id.*, page 11. Applicants respectfully disagree.

Applicants note that the '702 patent does not teach or suggest that calcium carbonate can "provide stability," as alleged by the Examiner as the sole basis for utilizing calcium carbonate in the composition. Rather, the '702 patent states, under the heading of "Insoluble Materials or Compounds" which the Examiner cites in the Office Action at page 11, that "[t]he materials or compounds which require stabilization can be soluble or insoluble in water." The '702 patent, col. 7, lines 14-16 (emphasis added). The '702 patent goes on to explain that calcium carbonate is an example of "insoluble compounds which require stabilization. . ." *Id.*, col. 8, lines 55-60 (emphasis added). Accordingly, calcium carbonate actually needs to be stabilized, rather than providing stability, as alleged by the Examiner. Thus, the Examiner's reasoning for the obviousness rejection is incorrect and Applicants respectfully request withdrawal of the rejection.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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By:



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